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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1965

No. 337

R. A. HANSON and R. A. HANSON CO., INC.,
Petitioners,

vs.

NO-JOINT CONCRETE PIPE CO.,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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BRIEF FOR RESPONDENT IN OPPOSITION

Respondent respectfully asks that the petition for writ of certiorari be denied on the grounds that the decision of the Court below was proper and just, and in full harmony with previous decisions of this Court and the various Courts of Appeal.

PRELIMINARY STATEMENT

In this brief we will refer to pages in the brief and petition of petitioners as "P.B. .....," to the appendix

to the petition as "P.A. ____," to the record on appeal as "R. ____," and to the trial transcript as "Tr. ____."

OPINION BELOW

The opinion of the United States Court of Appeals for the Ninth Circuit, printed at P.A. 7a-16a has been recently reported at 344 F.2d 13.

JURISDICTION

The jurisdiction requisites are adequately set forth in the petition at P.B. 2.

QUESTIONS PRESENTED

Petitioners' first question concerns the patent doctrine of file wrapper estoppel and range of equivalents, and may be rephrased as follows:

Whether the appellate Court below was correct in reviewing the prosecution in the Patent Office of the patent in suit, and in determining as a matter of law that the doctrine of file wrapper estoppel did not preclude respondent from asserting that the claims of the patent in suit were entitled to a range of equivalents sufficient to embrace petitioners' accused device.

The second question presented by petitioners may be rephrased as follows:

In an action for patent infringement, when a trial Court makes findings of ultimate facts of infringement based upon the application of the doctrine of equivalents to the patent in suit, the accused device and the prior art devices, is an appellate Court bound by the rule that such findings may not be set aside unless clearly erroneous,

or may an appellate Court draw its own conclusions as to the ultimate question of infringement.

STATEMENT OF THE CASE

The present case is a typical suit for patent infringement. The essential facts are related with clarity and precision in the detailed opinion of the Court of Appeals (P.A. 7a). The following merely highlights the factors of particular significance.

Respondent is the owner of United States Letters Patent No. 2,731,698 for a machine capable of forming concrete pipe in place in the ground, and brought suit for infringement based upon the manufacture and sale by petitioners of the accused pipe forming machine.

Respondent's patent in suit, models of respondent's pipe forming machine and petitioners' accused pipe forming machine and the prior art patents, were all before the District Court. The machines are not complicated and the construction and operation of each machine is readily understood. There was no dispute whatsoever as to the existence, construction and operation of the pipe forming machines of petitioners or respondent or of any of the prior art devices. Petitioners refer (P.B. 6-7) to the extent of the testimony before the trial Court but actualy there was no dispute in the testimony as to the construction, mode of operation and result of the patented and infringing devices or as to the prior art.

The District Court held the patent in suit to be valid, but concluded that the claims should be given a narrow construction in view of the history of prosecution of the patent in the Patent Office and that the accused device did not infringe because the inner form of the accused ma-

chine was in one piece, whereas the claims of the patent in suit called for a two-piece inner form.

The Court of Appeals had before it the patent in suit (Ex. 1), models of petitioners' and respondent's commercial pipe forming machines (Exs. 3 and 6) and the prior art. Motion pictures (Exs. 38 and 39) showing parallel operation of petitioners' and respondent's devices were shown to the Court of Appeals at the oral argument. The opinion of the Court of Appeals indicates that it understood clearly the construction and operation of the devices involved in the suit.*

The Court of Appeals reversed the District Court on the question of file wrapper estoppel and held that the respondent was not estopped by any of the proceedings in the Patent Office, to charge that the accused pipe forming machine was an infringement of the patent in suit.

The Court of Appeals then concluded that the patented and accused machines were not substantially different in construction, operation and results, and that the District Court improperly applied the doctrine of equivalents to the patent in suit. The Court of Appeals decided that the accused device came within the scope of the claims of the patent in suit and that infringement did exist.

A petition for rehearing was denied by the Court of Appeals. Thereupon, petitioners filed their petition for writ of certiorari.

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*In petitioners' argument on scope of the claims (P.B. 12) petitioners contend that two prior art patents (Exs. 41, 46) disclose devices that produce concrete pipe continuously. This position is inconsistent with District Court Finding of Fact 19 which, after a careful analysis of the prior art, states in part: "The said Tunsen patented machine was the first machine to make a continuous monolithic concrete pipe without joints or seams by the continual operation of a pipe making machine." The court below after its review of the prior art reached this same conclusion (P.A. 8a).

ARGUMENT

CERTIORARI SHOULD NOT BE GRANTED TO REVIEW THE QUESTION OF INFRINGEMENT OF THE PATENT IN SUIT.

This case turns on a determination of a question entirely peculiar to this case: Does the manufacture and sale of petitioners' pipe forming machine infringe the claims of the patent in suit?

There is no dispute about the legal test that governs. If the accused device performs substantially the same function in substantially the same way to obtain substantially the same result as the patented device, then there is infringement. This test has been clearly set forth by this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1949). The Court of Appeals, although it did not specifically refer to the *Graver Tank* decision in its opinion, applied the doctrine of equivalents and did not break any new ground.

Applying this test to the particular facts of this case, the Court of Appeals held the accused machine to infringe the patent in suit. In reaching its conclusion, the Court of Appeals considered the patent in suit, the accused machine and the prior art. These were not complicated devices, and there was no dispute as to the existence, construction, operation or intended purpose of any of these devices. No testimony was necessary to explain the meaning of any terms of the patent or prior art, nor to resolve questions of the application of descriptions to subject matter.

The ultimate question decided by the trial Court and appellate Court was whether, from an examination of this undisputed evidence, infringement existed; that is, whether the accused pipe forming machine having a one-piece inner form and the pipe forming machine of the patent in suit having a two-piece inner form were substantially the same in construction, mode of operation and

result. The trial Court believed that an extremely narrow range of equivalents existed and held that there was no infringement. Upon an examination of the same undisputed evidence, the Court of Appeals concluded that the patent was entitled to a broader range of equivalents and held that infringement did exist. In making its determination of this ultimate fact, the Court of Appeals was in as good a position to make such a determination as the District Court. The Courts below did not differ as to the rule of law, they merely differed as to the application of the law to the particular facts of this case.

The instant case does not conflict with the rule of law expressed by this Court in *Wright v. Yuengling*, 155 U.S. 47 (1894) (cited by petitioners at P.B. 15), which holds that the *elimination* of an element in a claim to a combination avoids infringement. Here there was a *substitution* of a one-piece inner form for a two-piece inner form in the patented combination, and the Court of Appeals merely followed the well-established rule that infringement is not avoided by merely making into one part that which has been shown as two. *Industrial Instrument Corp. v. Foxboro Co.*, 307 F.2d 783, 786 (5 Cir. 1962), *modified*, 310 F.2d 686 (1962); *Zysset v. Popeil Bros. Inc.*, 276 F.2d 354, 357-358 (7 Cir. 1960), cert. denied, 364 U.S. 826 (1960); *Specialty Equip. & Mach. Corp. v. Zell Motor Car Co.*, 193 F.2d 515, 518 (4 Cir. 1952); *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 693 (2 Cir. 1948) (L. Hand, J.), cert. denied, 335 U.S. 825 (1948); *Apex Mfg. Co. v. Maytag Co.*, 122 F.2d 182, 187 (7 Cir. 1941), cert. denied, 314 U.S. 687 (1941).

Petitioners now contend that the Court of Appeals is bound by the ultimate finding of the District Court regarding the question of infringement, and that the District Court cannot be reversed unless its determination of infringement is clearly erroneous. However, this Court has long held in patent cases that if no evidence is

needed to explain terms of art or to apply the descriptions of patents to the subject matter, and if the Court, from mere comparisons of the patent, accused device and prior art, is able to determine whether the accused device is the same or different from the patented device, then the question of infringement is one of pure construction and not of evidence and, consequently, is a matter of law for the Court. *Heald v. Rice,* 104 U.S. 737 (1882); *Singer Mfg. Co v. Cramer,* 192 U.S. 265 (1904); *Sanitary Refrigerator Company v. Winters,* 280 U.S. 30 (1929); *United States v. Esnault-Pelterie,* 303 U.S. 26 (1938).

The same rule is followed by the various circuits, namely, that in cases wherein the ultimate fact of infringement may be determined merely by a comparison of the patent and accused devices, the appellate Court is not bound by the "clearly erroneous" rule. *Hanovia Chemical & Mfg. Co. v. David Buttrick Co.,* 127 F.2d 888 (C.A. 1, 1942); *Plax Corporation v. Precision Extruders,* 239 F.2d 792 (C.A. 3, 1957); *Industrial Instrument Corporation v. Foxboro Co.,* 307 F.2d 783 (C.A. 5, 1962); *Del Francia v. Stanthony Corp.,* 278 F.2d 745 (C.A. 9, 1960).

The present case is not in conflict with the decisions of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.,* 336 U.S. 271 (1949) and 339 U.S. 605 (1950), where extensive testimony of experts was necessary to explain the subject matter of the suit in a field "where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience" (339 U.S. at 610). The field of endeavor of pipe forming machines is not one which is incomprehensible to Courts of law. This is evidenced by the fact that the trial in the District Court, which included not only an understanding

of the patent in suit, the accused machine and twenty-three prior art patents, took only two and one-half trial days.

Petitioners also contend that the Court of Appeals is in error because it held the patent to be infringed even though the claims did not read literally on the accused machine. This is not erroneous, but follows the rule laid down by the Court in the *Graver Tank* case, 339 U.S. 605, 607:

> "* * * One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system.
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> * * * * * * *
>
> "* * * Though infringment was not literal, the changes which avoid literal infringement are colorable only."

CERTIORARI SHOULD NOT BE GRANTED TO REVIEW THE QUESTION OF FILE WRAPPER ESTOPPEL.

In the present case the petitioners had relied upon the doctrine of file wrapper estoppel to escape liability for their infringement. The Court of Appeals, after a study of the file wrapper (the written history of the prosecution in the Patent Office) of the patent in suit, concluded that respondent was not estopped to charge petitioners with infringement.

This question, dependent upon the particular facts of this case, is not sufficient to warrant review by this Court.

General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175 (1938).

"* * * Whether respondents acquiesced in the infringement and are estopped depends on the facts. Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it."

Furthermore, in its opinion, the Court of Appeals below has followed the well-established rule that there is no basis for file wrapper estoppel if a patentee does not try to recapture, revive or restore something which had been abandoned or surrendered in the Patent Office. This is a rule that is uniform in the various circuits, as exemplified by *Upright, Inc. v. Safway Products, Inc.*, 315 F.2d 23 (C.A. 5, 1963), cert. den. 375 U.S. 831; *France Mfg. Co. v. Jefferson Electric Co.*, 106 F.2d 605 (C.A. 6, 1939), cert. den. 309 U.S. 657; *New York Scaffolding Co. v. Whitney*, 224 F. 452 (C.A. 8, 1915), cert. den. 239 U.S. 640; *Sears, Roebuck & Co. v. Jones*, 308 F.2d 705 (C.A. 10, 1962), cert. den. 371 U.S. 952; *M.O.S. Corporation v. John I. Haas Co.*, 332 F.2d 910 (C.A. 9, 1964).

PETITIONERS ARE IN ERROR WHEN THEY CONTEND THAT NO CONFLICT OF DECISION BETWEEN COURTS OF APPEAL INVOLVING THE INTERPRETATION OF THE CLAIMS IN ISSUE IS PROBABLE.

In their brief, petitioners assert that a conflict of decisions in this case is improbable because the use of the patented machine is concentrated in the Ninth Circuit such that it is unlikely that litigation could develop in other circuits.

However, the uncontradicted testimony of Mr. Williamson, President of respondent, shows use in Colorado (Tr. 155), the Tenth Circuit. Exhibit 11, a group of license agreements in existence in 1962, the time of the trial in the District Court, establishes licenses in the Tenth Circuit (New Mexico, Colorado and Kansas), Eighth Circuit (Missouri), as well as in the Ninth Circuit. Exhibit 11 also shows that at one time the license agreement to Phillip Congrove covered a part of the Fifth Circuit, but because the territory licensed to Congrove was so extensive, he gave up the territory in the Fifth Circuit.

THE INSTANT CASE DOES NOT INVOLVE ISSUES SIMILAR TO THOSE IN PATENT CASES PRESENTLY PENDING BEFORE THIS COURT.

Petitioners contend that this case presents questions similar to those raised in pending cases before this Court. However, this is not so.

In *U. S. v. Bert N. Adams, et al.*, No. 55, the question presented in the petition for certiorari is:

> "The question presented is whether the ruling of the court below, upholding the patent issued to respondent, seriously departs from the constitutional and statutory standard of invention."

In *Calmar, Inc. v. Cook Chemical Company*, No. 37, and *Colgate Palmolive Company v. Cook Chemical Company*, No. 43, the questions presented in the petitions are the same, namely:

> "*As to the Certiorari Policy:* Should not this Court at this point end its practice of the past fourteen years of leaving final authority in patent cases to the Courts of Appeals—a practice which has caused a degradation of the standard of patentability, leading to unjustifiable monopolization of many

segments of the economy—and participate once again in this field by granting certiorari in this extreme case which vividly illustrates the recurrent abuse and debasement of the constitutional standard of patentability?"

* * * * * * *

"The question presented is: Whether, because of the addition to these old elements of a ring serving as a sort of washer between the cap and the plunger collar, an addition obvious and disclosed by the prior art, the patent in question embodies a patentable 'invention' under the Constitution and §§ 101-103 of the Patent Code?"

In the present case, the District Court held the patent in suit to be valid, as did the Court of Appeals. Petitioners here do not challenge the validity of the patent in suit but merely raise questions concerning the doctrines of equivalents and file wrapper estoppel.

There is no similarity whatsoever between the issues of the present case and these above noted cases as contended by petitioners.

CERTIORARI SHOULD NOT BE GRANTED MERELY TO GIVE PETITIONERS ANOTHER HEARING.

The determination by the Court of Appeals that petitioners have infringed respondent's patent rests on an application of well-settled rules of law to the particular facts of this case. As this Court has often said, it does not exercise its certiorari jurisdiction to review this kind of determination, or to give an unsuccessful party in a Court of Appeals another hearing.

Magnum Import Co. v. Coty, 262 U.S. 159 (1923).

"* * * The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given

for two purposes, first to secure uniformity of decision between those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

CONCLUSION

For the reasons set forth above, the petition for a writ of certiorari should be denied.

Dated, San Francisco, California,
July 28, 1965.

Respectfully submitted,

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